

c3

GP 1643

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Attorney Docket No.: 18547-043210US

Assistant Commissioner for Patents
Washington, D.C. 20231

On 4/18/01

TOWNSEND and TOWNSEND and CREW LLP

By: Sandy Klein

RECEIVED
APR 25 2001
TECH CENTER 1600/2900
#6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Pirrung et al.

Application No.: 09/654,948

Filed: September 1, 2000

For: PHOTOLITHOGRAPHIC &
OTHER MEANS FOR
MANUFACTURING ARRAYS

Examiner: Unassigned

Art Unit: 1643

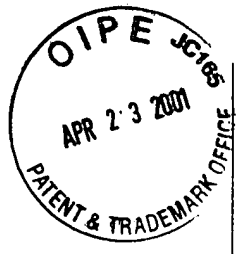
INFORMATION DISCLOSURE
STATEMENT UNDER 37 CFR §1.97 and
§1.98

BOX IDS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants are hereby submitting references for the Examiner's consideration. However, they are mindful of the large number of references that have been cited in the IDS and attendant 1449 form filed herewith. These references have arisen during multiple litigations and oppositions involving patents that relate to the present application as well as the normal course of prosecution. Applicants have cited them to fulfill their duty of disclosure. In an effort to make the review of these references more manageable on the Examiner, Applicants have provided the PTO with multiple copies of two compact discs (CDs) with the references available for electronically viewing or searching. Previous versions of this IDS and CD set



have been submitted to the PTO for references that were available at the time that the CDs were created. The current IDS incorporates additional references that have recently been disclosed in more recent litigation and a new version of the CDs (Version 3) has been prepared and sent to the PTO as discussed below.

Applicants representative, Mr. Philip McGarrigle, has provided the revised CDs to Supervisory Primary Examiners Michael Woodward and Gary Jones, and Special Examiner Cecilia Tsang. Previous versions were also given to these supervisors and Group Director John Doll. The CDs given to Mssrs. Woodward and Jones were for distribution to individual Examiners within their respective groups as they saw fit. The CDs presented to Examiner Tsang were to accompany the hard copies of the references in the IDS, which are in a central location in her office for the availability of all Examiners.

Of the two CDs that make up the IDS, one contains the articles and another contains patents/published applications. The CD containing the articles is in .pdf format and can be viewed by selecting the appropriate article as discussed below. The patent CD contains text versions and versions of the patents with the appropriate figures. It is fully searchable and contains a program that has the ability to search for specific terms or to use Boolean logic to formulate more specific searches. There are links within each full text patent to the patents that are cited therein.

The vendor who prepared the patent literature CD suggests that you open the README.HTML file in the root directory of the CD before use. It contains the directions on how to use the CD, as well as a hyperlink to the patent list. The CD that contains the articles suggests that you open "Index" or "Index2" to view images. You will see 1449 forms which list the articles which can be opened by clicking on the hyperlinked number of the article in the left hand column.

Additionally, Applicants would like to notify the Examiner of inter party matters that relate to the present application. Two commonly owned patents US 5,744,305 and

US 5,800,992 have been involved in interference proceedings. Specifically, the interferences were Interference No. 104,359 between commonly owned US 5,744,305 and Brown et al., USSN 08/688,488, and Interference No. 104,358 between commonly owned US 5,800,992 and USSN 08/514,875. Both interferences have been decided (subject to current appeal in District Court of Northern California, Civil Case No. C99 21111-JF/EAI) by the USPTO in favor of real party in interest Affymetrix, the assignee of the present application. The Junior party challenged the patents on the basis of lack of enablement and written description under 35 USC §112, among other issues. The Junior party's initial position is set out in papers (with supporting information) entitled "Request for Declaration of Interference, 37 C.F.R. §1.608" in both interferences. The initial response of Senior party Patentee is set out in papers (with supporting information) entitled "Fodor's Opposition to Brown's Rule 608(b) Request" in both interferences.

Further, US 5,744,305 and US 5,800,992 are the subject of litigation (*Affymetrix, Inc. v. Hyseq, Inc.*, US District Court for the Northern District of California, San Francisco Division, Civil Action No. C98-03192 FMS, and *Affymetrix. v. Synteni, Inc. and Incyte Pharmaceuticals, Inc.*, US District Court for the Northern District of California, San Francisco, Case No. C98-4508 FMS (MEJ)). In the course of these proceedings, allegations of invalidity over prior art, lack of enablement, lack of support and inequitable conduct (relating to duty of candor, content of declarations under 37 CR §1.132, and arguments made during prosecution) have been raised. These allegations are denied. In a more recent lawsuit with Incyte Genomics (*Incyte Genomics Inc. v. Affymetrix*, U.S. District Court, Northern district of California, San Francisco division and is Case No. C 00-3210 JF.), Affymetrix counterclaimed for patent infringement under U.S. patent 5,871,928 ('928) and 6,040,193. The '928 patent is in a related family to the present application. Incyte has filed their "Initial Disclosure of Prior Art" and the references cited therein have been included into the current IDS.

Further, oppositions have been filed against a related European application EP 619,321 in the European Patent Office, and a revocation proceeding has been brought in the United Kingdom against related patents GB 2,248,840 and EP (UK) 0619 321. Collectively, these proceedings have generated a considerable number of references, which were cited on the information disclosure statement and CDs filed above. Applicants can provide copies of litigation documents that may be of interest to the Examiner, but have not done so due to the extensive nature of the multiple litigation and papers filed therein.

The references cited on the attached form PTO-1449 are being called to the attention of the Examiner. Copies of the references can be found in a "Master Binder Set" originally submitted to Examiner Tsang on January 27, 2000 and supplemented on dates thereafter.

As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement, since it is being submitted prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No.



Pirrung et al.
Application No.: 09/654,948
Page 5

PATENT

20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,

Joseph R. Snyder
Reg. No. 39,381

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422
JS:crf

PA 3132754 v1